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NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			YU, GINA C	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/436,171

Filing Date: November 09, 1999

Appellant(s): BLECKMANN ET AL.

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HOWARD LEE  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on July 27, 20004.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1, 3-5, 7-9 and 11 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). While applicants assert, "claim 4 should be considered on its own merits and likewise", applicants provide no reasons to support the statement and claim 4 in fact depends on claim 1.

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct. Claims 1, 3-5, 7-9, and 11 are pending claims 2, 6, and 10 have been canceled.

**(9) Prior Art of Record**

6,338,858	DUPUIS ET AL.	01-2002
5,015,469	YONEYAMA ET AL.	05-1991
WO 98/17232	SCHREIBER ET AL.	04-1998
6,613,338 B1	SCHREIBER ET AL.	09-2003

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claims 1, 3, 5, 7-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al. (WO 98/17232) in view of Dupuis et al. (6,338,858).**

The instant invention is directed to a water-in-oil emulsion with a content of water and optionally water-soluble substances totaling greater than 85% by weight, and with a content of lipids, emulsifiers and lipophilic constituents of less than 15% by weight, comprising a surface-active substance of formula (f), and a cationic polymer.

Schreiber et al. teach water-in-oil emulsions comprising 30-85% of an aqueous phase, and preferably 1-20% of a lipid phase and a surface active substance of formula (1) of the instant invention. PEG-30 dipolyhydroxystearate is disclosed as a surface-active substance. Oils disclosed include branched and unbranched hydrocarbons. The reference lacks cationic polymers. See pg. 4- 15; pg. 17; pg. 19-40. See US 6,613,338 B1 (English equivalent), col. 3, line 32 – col. 10, line 10; col. 11, lines 2 – 27; col. 11, line 65 – col. 23, line 10.

Dupuis et al. teach aqueous solid topical compositions. Water-in-oil emulsions are disclosed as cosmetic forms. Cationic polymers, comprising 0.001-5% of the

compositions, are disclosed as conditioning agents for use in the compositions. Specifically disclosed as a cationic polymer is JR 400, wherein JR 400 is polyquaternium-10. See col. 1, lines 1-30; col. 5, lines 51-57; col. 7, lines 59-col. 8, line 20.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the cationic polymers of Dupuis et al. to the compositions of Schreiber et al. because a) Schreiber et. al. and Dupuis et al. are both directed to cosmetic water-in-oil stick emulsions, wherein lipsticks are specifically exemplified; b) Dupuis et al. teach that adding cationic polymers to such emulsions results in a conditioning effect; hence, one of ordinary skill in the cosmetic art would be motivated to add the cationic polymer taught by Dupuis et al. into the composition of Schreiber et al. because of the expectation of achieving a composition that imparts conditioning benefits to the skin, especially to the lips.

**Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al. in view of Dupuis et al. as applied to claims 1, 3, 5, 7-9 and 11 above, and further in view of Yoneyama et al. (US 5,015,469).**

Schreiber et al. and Dupuis et al. are applied as discussed above. The references lack preferred oils.

Yoneyama et al. teach water-in-oil emulsion type cosmetics comprising cationic surfactants. Hydrocarbon oils such as liquid paraffin, isopropyl myristate, waxes such as petrolatum, and silicone oils are disclosed as comprising the oil components. See abstract; Col. 5, line 5-Co1. 6, line 2.

Art Unit: 1617

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the liquid paraffin of Yoneyama et al. for the oils taught by the combined references because a) the combined references and Yoneyama et al. are both directed to water-in-oil cosmetic emulsions, b) the combined references teach isopropyl myristate and silicone oils for use in their oil phase and Yoneyama et al. teach liquid paraffin as interchangeable with isopropyl myristate and silicone oils in the oil phase of cosmetic water-in-oil emulsions; thus, one of skill in the art would be motivated to teach liquid paraffin in the composition of the combined references because of the expectation of achieving similar cosmetic oil effects and because the combined references teach that their oil phase can comprise branched and unbranched hydrocarbons.

**(11) Response to Argument**

In response to applicants' assertion that the Office failed to establish a prima facie case of obviousness, examiner respectfully disagrees and answers as following.

**I. Claims 1, 3, 5, 7-9, and 11 are properly rejected over Schreiber in view of Dupuis.**

**A. The claimed invention is prima facie obvious in view of the collective teachings of Schreiber and Dupuis references considered as a whole.**

Applicants recite the summary of each of the Schreiber and Dupuis inventions to point out that, while both are directed to stick formulations, Dupuis "is not as clearly directed" to a water-in-oil emulsions. Applicants' assertion is unpersuasive because, as indicated in the Office action, the Dupuis reference states in col. 5, lines 52-57, "In this

case, the fatty phase can be dispersed in the gel, in particular in the form of an emulsion of oil-in-water or **water-in-oil** type.” (emphasis inserted).

**B. One of ordinary skill in cosmetic art would have been motivated and found it desirable to combine the teachings of the Schreiber and Dupuis references to make the claimed invention.**

Applicants assert that, even if there was the requisite motivation to combine the references, the difference of having an aqueous phase greater than 85 % by weight still is not addressed by the combination of the references. Specifically, applicants assert that, because the Schreiber and Dupuis inventions are stick preparations, it “would appear to place a cap” on the possible amount of the aqueous phase to make a formulation comprising 99 % of aqueous phase and 1 % of lipid phase.

Applicants’ argument is unpersuasive because the claim limitation merely requires the amount of the aqueous phase comprising water and water-soluble substance be greater than 85 %. Schreiber teaches that its solid composition may comprise up to 85 % of water, and applicants’ limitation “greater than 85 %” can be, for example, 85.001 %. The claimed weight limitation of the aqueous phase is thus rendered obvious by the teaching of Schreiber.

With respect to the limitation on the cationic polymers, applicants assert that the “discussion on obviousness in In re Fine closely adheres to the position maintained by the applicants”. Applicants’ position, however, is not supported by any facts or reasons. The rejection clearly indicates that one of ordinary skill in the art would have been motivated to incorporate the claimed cationic polymers because of the objective teaching on the beneficial cosmetic properties of the ingredient. Applicants merely state

Art Unit: 1617

that this logic “does not constitute a teaching or suggestion” to use the cationic polymers. Applicants further asserts that the examiner’s cited reason is “her own opinion and does not arise from the teachings of the prior art themselves”. These arguments are erroneous and unjustifiable, as the fact that the specific cationic polymer polyquaternium -10 is a conditioning agent is clearly found in the Dupuis reference. It would have been obvious to a routineer in cosmetic art to employ the cationic polymer to make a cosmetic composition which imparts skin conditioning effects.

**C. No impermissible hindsight is used in establishing the prima case of obviousness, as the rejection is solely based on the objective facts found in the references.**

Applicants assert, “there is no reason for one of ordinary skill in the art to magically select the cationic polymer portion of the teaching of Dupuis to the exclusion of all the other critical and non-critical elements of Dupuis’ invention”. Examiner reiterates that “the reason” to employ the claimed cationic polymer is found in the Dupuis reference itself. It would have been obvious to a reasonable skilled artisan that the polyquaternium-10 is useful as a conditioning agent in cosmetic formulations in general, and not in the Dupuis invention only. There is nothing “ambiguous” about using a cosmetic conditioning agent to impart a conditioning effect. Furthermore, applicants’ claim is not limited to the composition of the claimed components only; the claim is open to include any of the components taught by the Dupuis reference.

It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the specific cosmetic properties of the cationic polymer and its application in water-in-oil emulsion are objectively taught in the Dupuis reference, which was available to skilled artisans at the time of the present invention.

**The prima facie case of obviousness is properly established as there is a reasonable expectation of success.**

Applicants assert that "there is still no factual evidence that it was possible to exceed the 85 % by weight aqueous phase for a water-in-oil emulsion" based on the teachings of Schreiber and Dupuis. As discussed above, applicants' limitation encompasses even a slight variation of the prior art. As discussed in the Office action, there exists a reasonable expectation of successfully making the claimed invention by incorporating the Dupuis cationic polymer into the Schreiber emulsion stick composition because both prior arts are directed to cosmetic water-in-oil stick emulsions, wherein lipsticks are specifically exemplified.

**II. Claim 4 is properly rejected over Schreiber and Dupuis, and further in view of Yoneyama.**

**A. Applicants' invention in Claim 4 is prima facie obvious considering the teachings of Schreiber, Dupuis, and Yoneyama references as a whole.**

Applicants state, "each of Yoneyama's examples possesses less than 85 % aqueous phase and there is no indication that they were able to overcome the limitations of the art as described by the appellants in their specification". In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

Art Unit: 1617

combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, making a water-in-oil emulsion stick composition comprising up to 85 % of water phase is already taught by Schreiber. Yoneyama is cited merely to show that using liquid paraffin in a cosmetic water-in-oil emulsion would have been obvious to one of ordinary skill in the art.

**B. The obviousness rejection is proper since the motivation to combine the reference is found in the collective teachings thereof.**

Applicants state “it is unclear why or how one of ordinary skill in the art . . . would have known to select only the oil phase teaching portion of Yoneyama to combine with Schreiber absent any further guidance”. The answer is directly found in the examiner’s rejection as indicated in the Office action dated July 10, 2003. There, examiner had indicated that it would have been obvious to incorporate the hydrocarbon oils of the Yoneyama reference to the composition of Schreiber because the former teaches the equivalence among isopropyl myristate, liquid paraffin, and silicone oil in making a water-in-oil emulsion cosmetic composition. Since branched and unbranched hydrocarbons and silicone oil are also taught in the Schreiber invention, the skilled artisan would have had a reasonable expectation to successfully make a similar cosmetic emulsion by substituting the liquid paraffin of Yoneyama for the oils of Schreiber. Here, liquid paraffin, branched hydrocarbon such as isopropyl myristate, and silicone oil (cyclomethicone) are art-recognized equivalents known for the same purposes, thus the substitution as proposed by the examiner would have been *prima facie* obvious. See In re Ruff, 256 F.2d 590, 118 USPQ 340 (CCPA 1958); Sinclair &

Art Unit: 1617

Carroll Co. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945); MPEP § 2144.06.

**C. The obviousness rejection is not based on impermissible hindsight, since the rejection is based on the objective facts found only in the references.**

While applicants assert that the proposed combination of Yoneyama with Schreiber and Dupuis only amounts to improper picking and choosing, examiner respectfully disagrees. The rationale to use the claimed liquid paraffin is fully supported by the above cited legal authorities which hold that a prima facie case of obviousness is established so long as the references teach that the components used by applicants and prior arts are art-recognized equivalency known for the same utility. In this case, substituting branched hydrocarbons with liquid paraffin proposed by examiner in no way constitutes an impermissible hindsight but a prima facie obvious variation of the prior arts.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Gina Yu  
Patent Examiner  
January 21, 2005

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